

### **REMARKS**

Claims 1, 3, and 9-14 were examined. Claims 1, 3, and 9-11 are rejected and claims 12-14 are allowed. Applicants amend claims 1 and 10 and assert that no new matter has been added therein. Accordingly, Applicants respectfully request reconsideration of pending claims 1, 3, and 9-11, as amended, in view of at least the following remarks.

#### **Claims Rejected Under 35 U.S.C. §112**

The Patent Office rejects claims 1, 3, and 9 under 35 U.S.C. §112, first paragraph, because "the metal oxide on the surface of the compound excludes Li" as required by claim 1 is not supported by the original specification. Applicants respectfully disagree and believe that the above quoted limitation of claim 1 is proper and is supported by the original specification because that specification would have conveyed to one having ordinary skill in the art that the Applicants had possession of the concept of coating the surface of a positive active material for a lithium secondary battery with a metal oxide coating that excludes lithium. (See MPEP §2173.05 (i), and Ex parte Parks, 30 USPQ2d 1234, 1236 (1993)).

Specifically, lithium is a well known battery metal. Also, Applicants point out that lithium is mentioned throughout the specification as a metal contemplated for use in the positive active material, lithium is not mentioned in any examples of the metal oxide coating (such examples include specific metal alkoxide solutions such as  $Al_2O_3$ ), and a lithium metal-metal oxide coating on an active material is known in the art (as the Patent Office points out and admits WO 097/49136 issued to Li shows). Therefore, although Applicants' metal oxide coating would seem to cry out for the inclusion of lithium, no mention is made of including lithium in that coating. Hence, Applicants respectfully request that the Patent Office withdraw the rejection of claims 1, 3, and 9 under 35 U.S.C. §112 because the above quoted limitation of claim 1 is supported in the original specification because the Applicants had possession of the concept of including

lithium in their metal oxide coating, contemplated such inclusion, but chose to exclude lithium from their metal oxide coating.

**Claims Rejected Under 35 U.S.C. §102**

The Patent Office rejects claims 1, 3, and 9 under 35 U.S.C. §102(b) as being anticipated by Li Patent WO 097/49136 ("Li"). Applicants submit that amended independent claim 1 is not anticipated by Li for at least the reason that Li does not describe a metal oxide coating that excludes lithium and is an oxide of a metal selected from the group consisting of Mg, Ti, Al, V, Co, K, Ca, and B in accordance with amended independent claim 1. It is axiomatic that to be anticipated every element of a claim must be disclosed within a single reference.

Li teaches an alkali metal-metal oxide or an alkali metal-mixed metal oxide coating (see page 6 line 8 through page 8 line 2). Specifically, the examples of the coatings given in Li are a metal oxide including lithium (Li).

On the other hand, the Patent Office has not identified and Applicants are unable to find any description in Li of a metal oxide coating in accordance with the above metal requirements of amended independent claim 1, and that does not contain lithium. Therefore, the oxide of a metal selected from the group consisting of Mg, Ti, Al, V, Co, K, Ca, and B of Applicants' claim 1 is not described by the alkali metal-metal oxide coating of Li which requires lithium. Hence, Applicants respectfully request that the Patent Office withdraw the rejection of amended independent claim 1 under 35 U.S.C. §102(b) as being anticipated by Li.

Applicants respectfully submit that dependent claims 3 and 9 are allowable for at least the same reason as allowable independent claim 1, from which they depend. Thus, Applicants respectfully request that the Patent Office withdraw the rejection of claims 3 and 9 under 35 U.S.C. §102(b) as being anticipated by Li.

**Claims Rejected Under 35 U.S.C. §103**

Claims 1, 3, and 9-11 are rejected under 35 U.S.C. §103(a) as being unpatentable over Nishida et al. Patent JP 08-236114 ("Nishida") in view of Miyasaka, U. S. Patent No. 6,037,095 ("Miyasaka"). Applicants respectfully disagree and submit that amended independent claims 1 and 10 are allowable for at least the reason that the cited references do not teach a positive active material compound comprising  $\text{Li}_a \text{Ni}_{1-x-y} \text{Co}_x \text{M}_y \text{O}_2$  where M is a metal selected from the group consisting of Sr, La, Ce, and V, as required by amended independent claims 1 and 10. To render a claim obvious all elements of that claim must be taught or suggested by at least one properly combined reference.

Miyasaka teaches a lithium secondary battery having a positive electrode material including Li, Ni, Co, M, O, and X, where M may be Al, Mg, or Ti, and X is a halogen atom. However, the Patent Office has not identified and Applicants are unable to find any teaching in Miyasaka of a positive active material as required by the limitations of amended independent claims 1 and 10 noted above. Moreover, Applicants respectfully submit that Nishida does not remedy the defects of Miyasaka. Therefore, since Miyasaka, Nishida, nor the combination teaches the above mentioned requirements of independent claims 1 and 10, Applicants respectfully request that the Patent Office withdraw the rejection of amended independent claims 1 and 10 under 35 U.S.C. §103(a) as being unpatentable over Nishida in view of Miyasaka.

Applicants respectfully submit that dependent claims 3, 9 and 11 are allowable for at least the same reasons as allowable independent claims 1 and 10, from which they depend. Thus, Applicants respectfully request that the Patent Office withdraw the rejection of claims 3, 9 and 11 under 35 U.S.C. §103(a).

**CONCLUSION**

In view of the foregoing, it is believed that all claims now pending (1) are in proper form, (2) are neither obvious nor anticipated by the relied upon art of record, and (3) are in condition for allowance. A Notice of Allowance is earnestly solicited at the earliest possible date. If the Patent Office believes that a telephone conference would be useful in moving the application forward to allowance, the Examiner is encouraged to contact the undersigned at (310) 207-3800.

If necessary, the Commissioner is hereby authorized in this, concurrent and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17, particularly, extension of time fees.

Respectfully submitted,

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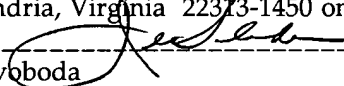
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**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, Post Office Box 1450, Alexandria, Virginia 22313-1450 on December 10, 2003.

  
Jean Svoboda